

REMARKS

Claims 1, 2, 6, 7, 8, 11, 12 and 13 presently stand rejected as being unpatentable in view of U.S. Patent 5,854,976 ("Garcia"), and claims 3-5, 9, 10 and 15-16 stand rejected in view of the proposed combination of the Garcia disclosure and U.S. Patent 6,212,372 ("Julin"). The rejection of the pending claims of the present application is respectfully traversed on the basis that the Garcia and Julin disclosures, whether considered individually or collectively, fail to teach or suggest the mobile radio system of claims 1-5, the method for operating mobile terminals according to claims 6-12, and the subscriber identity module according to claims 13, 15 and 16 of the present application.

The Garcia disclosure describes a method in which a subscriber identification number is replaced with a newly generated, secret subscriber identification number (col. 2, lines 37-42). As will be discussed below, however, the subscriber identification number in the Garcia disclosure is akin to a personal identification number and is not to be confused with an international mobile subscriber identity ("IMSI").

As taught by the Garcia disclosure, a subscriber identification number is a number provided for authentication of a subscriber identity (col. 3, lines 41-43). Moreover, the Garcia disclosure particularly points out that it is only after the verification of the subscriber identification number that the subscriber identity module ("SIM") becomes fully activated and permits access to all the functions resident therein (col. 3, lines 43-47). The subscriber identification numbers are transmitted to the SIM via the commands VERIFY CHV or CHANGE CHV. As particularly explained in the Garcia disclosure, subscriber identification numbers are composed of 4 to 8 digits with a number of zeros added until an 8-digit number is obtained (col. 3, lines 26-34).

In comparison to a subscriber identification number, an IMSI is not used for fully activating a SIM but instead is provided for identifying a subscriber's identity across a GSM network. Moreover, an IMSI has a predefined content consisting of more than 4 digits (MCC: 3 digit country code, MNC: 2 digit network operator code; and a serial code of maximum 10 digits for the use of the network operator).

Thus, in view of these observations, it is readily clear that a subscriber identification number and an IMSI are known to a skilled artisan as having different technical functions. While a subscriber identification number is used for authenticating a subscriber against a SIM, an IMSI is provided for authenticating a SIM module against a GSM system.

As recited throughout the pending claims of the present application, the mobile radio system, method for operating mobile terminals, and the subscriber identity module include newly creating at least one IMSI. While it is alleged in the Office Action that the Garcia disclosure teaches creating a new IMSI, the Examiner has failed to clearly explain how the subscriber identification number described therein could be construed a IMSI. Applicants submit that the Garcia disclosure simply fails to teach or suggest a step for or means of creating a new IMSI.

According to the Julin disclosure, it is made abundantly clear therein that a subscriber identification number and an IMSI are distinctively different. In this prior art reference, each subscriber is provided with an individual secret identification number for selectively activating an identity function in a SIM (col. 2, lines 17-32). The identification number is provided in a common manner by a subscriber for authenticating a subscriber against a SIM (col. 2, lines 24-27), and the SIM recognizes that the current subscriber is authorized to use the SIM. According to the Julin disclosure, an identity (such as IMSI 1 or IMSI 2) is selected either on the basis of an identification number or on the basis of an additional code element for selecting the identity (col. 2, 32-36; col. 4, lines 61-64; claim 3).

As detailed in previous correspondence in response to prior rejections of the pending claims in the above-application, the Julin disclosure fails to teach or suggest a mobile radio system including a calculation rule that calculates and generates a "new" identity from the stored identity (IMSI). Moreover, the Julin reference fails to overcome the shortcomings of the Garcia disclosure and demonstrates how it is unambiguous to a skilled artisan that a subscriber identification number is different from an international mobile subscriber identity (IMSI).

Turning back to the Garcia disclosure, this reference is concerned with fixed cellular terminals (TCF) and not to cellular mobile terminals (TCM) of the system (col. 3, lines 12-14; claim 1). The establishment of a new subscriber identification number is created in the stationary terminal TCF (col. 4, lines 16 to 34). According to the Garcia disclosure, the new subscriber identification number is stored in the SIM module to replace the subscriber identification number currently stored therein (col. 4, lines 38-42). In particular, the new subscriber identification number is secret and is neither known to the subscriber nor to the system operator (col. 4, lines 51 to 61). Consequently, the SIM module with the new and secret subscriber identification number cannot be freely used in the system, and the new secret subscriber identification number can only be used in connection with the stationary terminal.

In sum, the Garcia disclosure teaches changing the subscriber identification number of the SIM in stationary terminals in order to prevent free use of the SIM. Accordingly, there is no teaching or suggestion in the Garcia disclosure of the method according to claims 1 and 2 of the present application.

In making a rejection based on obviousness, particular findings and specific reasons must be provided as to why a skilled artisan would have been motivated to select references and to combine them to render a claimed invention obvious. See *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); See also *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). Evidence of the motivation, suggestion or teaching may come explicitly from

statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether an express or implicit showing is relied upon, particular findings related thereto must be provided therewith. *Id.* When general knowledge is relied upon to negate patentability, that knowledge must be articulated in the record and cannot be resolved on "subjective belief and unknown authority." *In re Lee*, 277 F.3d 1338, 1342-45, 61 U.S.P.Q.2d 1430, 1433-1435 (Fed. Cir. 2002)

While the Examiner has proposed combining the teachings of Garcia and Julin to carry out the system, method and module of the present application, no objective evidence has been proffered from either the Garcia or Julin references that would motivate a skilled artisan to make the present invention. Instead, merely conclusory statements that it would be obvious to a skilled artisan to combine the Garcia and Julin references have been provided by the Examiner, and it appears that the proposed combination is based on such "subjective belief and unknown authority" that is insufficient to establish an obviousness rejection.

Applicants respectfully request the Examiner to provide objective evidence from the Garcia and Julin disclosures that would suggest to a skilled artisan that it would be desirable to combine the teachings of such disclosures to make the mobile radio system of claims 1-5, the method for operating mobile terminals according to claims 6-12, and the subscriber identity module according to claims 13, 15 and 16 of the present application.

Applicants submit that even if the disclosures of Garcia and Julin were combined, a skilled artisan would not result in making the present invention. This is due to the incompatibility of the teachings of Garcia and Julin since they describe different methods for solving different technical problems.

Application No.: 09/485,679
Examiner: Sheila B. Smith
Art Unit: 2681

In summary, Applicants have carefully considered the rejections of the pending claims, and such rejections are respectfully traversed for the reasons discussed above. Accordingly, Applicants respectfully request reconsideration of the rejections and the withdrawal thereof.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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